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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,150	02/11/2004	Joshua A. Gerak	PL050021	2149

37621 7590 08/24/2005
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EXAMINER

WONG, STEVEN B

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/708,150

Applicant(s)

GERAK ET AL.

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18-24, 26 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15 is/are allowed.
- 6) ☒ Claim(s) 16, 18-24, 26 and 28-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 30 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification does not support the newly filed limitations reciting stitching directly through the crocheted fabric in loops in a manner that presents mirrored messages on opposing sides of the fabric.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 16, 18-24, 26, 28, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bissell (660,787) in view of Ellis (2,399,478), Contini (6,067,660) and Conrad (3,662,878). Note the basis for the rejections set forth in the Office Action mailed April 4, 2005. Regarding newly submitted claim 31, note the rejection of claim 16.

Response to Arguments

5. Applicant's arguments filed June 6, 2005 have been fully considered but they are not persuasive. The applicant argues that the combination of Bissell in view of Ellis, Contini and Conrad do not teach the claimed invention because it would be impossible for one to have access

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to the inside surface to sew the embroidery. However, this is not persuasive as Contini particularly teaches applying by embroidery a patch to a substrate. Clearly, one of ordinary skill in the art would have access to the inside surface to sew the embroidery thereon during the crocheting of the ball. While the applicant may have created a novel method for applying the embroidery to the ball surface, claims 16, 18-24, 26, 28, 29 and 31 are directed to the apparatus and are not limited by the method of manufacture.

The applicant argues that they have come up with a novel method of embroidery involving embroidery sewed onto an initial disc and further crocheting to form the sphere. As noted above, while this method may be novel, the rejected claims are directed to the apparatus itself. The method which applicant argues is novel is presented in claims 1-15 and those claims have already been indicated as being allowable.

Regarding the applicant's argument that nowhere has anyone succeeded in embroidering upon the spherical surface of a ball, this argument is not persuasive as it is not supported by any factual evidence and appears to be based on the applicant's own subjective opinion. The applicant argues that the small opening of a ball does not provide adequate space for utilizing the conventional solutions (a support base for holding the fabric). However, this argument is also not persuasive as it is also based upon the applicant's own opinion. As balls of varying sizes are known in the art, it is seen that a ball of a rather large size would provide sufficient space for any support base to be inserted therein which would permit the embroidering of the patch thereon.

Regarding the applicant's arguments directed to Ellis, the applicant contends that the conventional crochet work of Ellis requires the needle to be pushed through the medium being embroidered upon. While this may be true, as noted above a ball of a rather large size would

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provide a sufficient space during its manufacture that could permit the needle to be manipulated through the medium. Regarding the applicant's argument that the prior art is absent a teaching of applying embroidery to a non-planar surface, attention is directed to page 10 of applicant's own remarks filed June 6, 2005. Here, the applicant admits on the record that the Patent Office has issued patents for embroidery upon non-planar surfaces such as clothing or caps. The embroidery of a cap is seen as no different than the embroidery of a ball that is only partially completed and in the shape of a hemisphere.

Regarding the applicant's arguments directed to the Conrad patent, this reference is cited merely for its teaching that it is well known in the art of patches to form the patch by embroidery. The combination of Bissell in view of Ellis and Contini teach the embroidering of the patch to the crocheted ball.

The applicant's remarks directed to the Schiffli reference have been fully considered but are not deemed to be persuasive as the Schiffli patent is not relied upon in the rejection.

Regarding the applicant's remarks directed to the Bissell reference, the applicant contends that because Bissell includes a resilient center, it is impossible for one to have access for permitting a needle to be pushed through. However, this argument is not persuasive as it relies on the method of manufacture of the instant invention and the prior art. Clearly, one of ordinary skill in the art could manufacture the ball of Bissell and during that manufacture before insertion of the resilient center have access to the inside surface for embroidery purposes. The reference to Bissell is absent any statement or teaching that limits the ball to be inserted during the initial manufacturing steps of the ball or that the invention would not function if the user inserted the ball towards the end steps of the manufacturing process.

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Regarding the arguments directed to the dependent claims, the recited dimensions have been considered to be obvious given the teachings of the cited art and the lack of a teaching for the criticality of the claimed dimensions by the demonstration of a new and unexpected result obtained therefrom by applicant.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

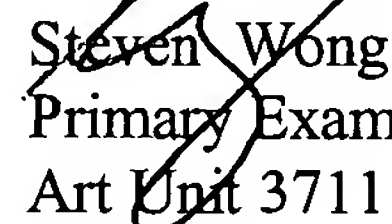
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Wednesday 7am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
August 22, 2005